

REMARKS

The applicants have carefully considered the official action dated September 28, 2005, and the references it cites. In the official action, claims 1-4 were rejected under 35 U.S.C. § 112 as indefinite; claim 1 was rejected under 35 U.S.C. § 102(b) as anticipated by Murata; claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as unpatentable over Murata in view of general knowledge in the art; and claim 4 was rejected under 35 U.S.C. § 103(a) as unpatentable over Murata in view of Debany. In view of the foregoing amendments and the following remarks, the applicants respectfully traverse the outstanding objection and rejections and respectfully submit that all pending claims are in condition for allowance. Favorable reconsideration is respectfully requested.

The applicants respectfully submit that claim 1 particularly points out and distinctly claims the subject matter that the applicants regard as their invention in accordance with the second paragraph of 35 U.S.C. § 112. It is well established that to be definite under the second paragraph of § 112, the scope of a claim must be clear to “a hypothetical person possessing the ordinary level of skill in the art.” *MPEP* § 2171. A claim should be examined against § 112 to determine whether the claim “meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available,” and the claim should be allowed if it defines “the patentable subject matter with a reasonable degree of particularity and distinctness.” *MPEP* § 2173.02 (emphasis in original). Further, in examining the claim “[s]ome latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire,” and examiners “should not reject [a claim] or insist on their own preferences if other modes of expression selected by [the] applicants satisfy the statutory requirement.” *Id.*

The applicants respectfully submit that claim 1 is definite in accordance with the second paragraph of § 112 because it would be interpreted by one of ordinary skill in the

pertinent art in a manner that would provide clear and unambiguous notice to others “as to what constitutes infringement of the patent.” *Id.* In particular, claim 1 is directed to a system comprising, *inter alia*, “a bit stream comparison unit to compare...” and “a multi-source agreement compliant electrical connector to convey....” The applicants respectfully submit that one of ordinary skill in the art would interpret the bit stream comparison unit as one used to perform a compare operation and the multi-source agreement compliant electrical connector as one used to convey bit streams. These are clear and unambiguous functions that provide notice to others required as by the second paragraph of § 112. *Id.*

In this case, the examiner has failed to explain how the elements recited in claim 1 create ambiguity or fail to define with “a reasonable degree of particularity and distinctness” the patentable subject matter. *Id.* (emphasis in original). Instead, the examiner merely asserts that “the subjunctive mood and conjugation in Grammar is indefinite.” The applicants respectfully submit that the examiner’s position is legally erroneous. Even if the examiner’s grammatical characterization of the claim language at issue here is correct, a point which the applicants do not concede, the examiner has failed to provide any evidence or support for his position that the use of the subjunctive mood and/or conjugation necessarily results in indefiniteness under 35 U.S.C. § 112. On the contrary, it appears that the examiner has created his own legal basis for making his rejection and, thus, has failed to apply the proper legal standard. Namely, the examiner has failed to explain how the claim language at issue here creates ambiguity or fails to define with a reasonable degree of particularity and distinctiveness the patentable subject matter, or why the scope of claim 1 would not be clear to a person of ordinary skill in the art.

Furthermore, on page 2 of the official action the examiner assumes that “to convey” means “conveying” and that “to compare” means “that compares” and, thus, appears to be alleging that the structures comprising the system recited in claim 1 must be active or

operational to satisfy the requirements of 35 U.S.C. §112. Such a position is legally flawed. There is no supportable legal position for requiring an applicant to adopt claim language requiring active operation of one or more elements of a system or apparatus claim. On the contrary, such a requirement, if it existed, would only serve to prevent an applicant from protecting a product in an “on the shelf” condition. In other words, under the examiner’s apparent regime, an applicant would not be able to prevent others from making and selling (i.e., not operating or using) a system or apparatus constructed in accordance with the teachings of their invention.

If the examiner elects to maintain the § 112 rejection, the applicants respectfully request a more detailed explanation as to why claim 1 is indefinite and fails to describe the claimed invention with a reasonable degree of particularity and distinctness. Otherwise, the applicants respectfully request withdrawal of the § 112 rejection to place the application in better condition for appeal by reducing the number of pending issues.

Turning to the art rejections, the applicants respectfully submit that independent claim 1 is in condition for allowance. Independent claim 1 is directed to a system including a multi-source agreement compliant electrical connector that directly couples to a multi-source agreement (“MSA”) compliant device. The examiner maintains that Murata teaches an MSA compliant electrical connector, namely sending and receiving circuits (1) and (2). However, the applicants again respectfully submit that Murata does not teach an MSA compliant electrical connector, as recited in claim 1. On the contrary, Murata teaches sending and receiving circuits (1) and (2), neither of which can be fairly construed to be connectors.

The applicants maintain that the sending circuit (1) and the receiving circuit (2) described by Murata cannot be construed to be a connector, much less an MSA compliant connector, as recited in claim 1. The examiner has clearly adopted an improper and unfairly

broad meaning for the term “electrical connector.” Namely, the examiner believes that the term “connector” means “a coupling device employed to connect conductors of one circuit or transmission element with those of another circuit or transmission element.” The examiner further reasons that because the sending and receiving circuits (FIG. 1) of Murata connect electrical circuitry with the tester to elements outside the tester, the sending and receiving circuits are “connectors.”

Further, the examiner’s overly broad definition of the term ‘connector’ contradicts the plain meaning that would be given the term by one of ordinary skill in the art in light of the applicants’ specification. During examination, a claim term should be given the broadest reasonable interpretation that is consistent with the applicant’s specification and “should be read in light of the [applicant’s] specification as it would be interpreted by one of ordinary skill in the art.” *In Re Cortright*, 165 F.3d 1353, 1358 (Fed. Cir. 1999) (quoting *In re Bond*, 910 F.2d 831, 833 (Fed. Cir. 1990)). The *Cortright* court rejected the interpretation given to a claim term by the examiner and the Board of Patent Appeals and Interferences (“the Board”) for being so broad that it was inconsistent with the Cortright specification and overextended the interpretation that it would be given by one of ordinary skill in the art in light of the Cortright specification. *Id.*, at 1359.

The applicants’ specification describes a plurality of functional blocks that may be implemented using circuits and describes as separate from those functional blocks an MSA compliant connection (16) that may be implemented using an MSA electrical connector. In light of the applicants’ specification, one of ordinary skill in the art would not construe an MSA compliant electrical connector to mean a circuit as suggested in the official action. The applicants’ specification describes an example embodiment in which an MSA electrical connector may be implemented using a connector having a unitary body including a plurality of electrical contacts such as, for example, a 300-pin grid array type connector, an example of

which is described in a reference document filed in an information disclosure statement in this application on June 5, 2002. Additionally, the applicants' specification references an example part (i.e., Framatome Connectors International part number 84500-002), which may be used to implement the MSA compliant electrical connector.

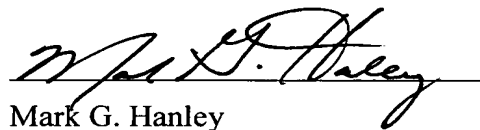
In this case, the examiner has placed improper emphasis on a dictionary definition and has impermissibly ignored the applicants' specification and, thus, has improperly divorced his interpretation of the term "connector" from the context of the applicants' invention. Although dictionary definitions can be looked to for guidance and aid in interpreting claim terms, such dictionary definitions should be read in light of applicants' specifications to give the claim terms the meanings intended by the applicants and to safeguard against overextending beyond the teachings in the applicants' specifications. *MPEP* § 2111.

Application of the logic used by the examiner clearly illustrates the overly broad meaning adopted by the examiner in this instance. For example, the sending and receiving circuits disclosed by Murata also inherently have a capacitance, an inductance, and are affected, at least to some extent, by external electrical signals (e.g., electromagnetic interference, electrostatic discharge, etc.). Thus, using the examiner's logic, it would also be fair to characterize the sending and receiving circuits of Murata as capacitors, inductors, and/or or antennas; characterizations that the applicants respectfully submit would be readily rejected by those of ordinary skill in the art as failing to properly describe the sending and receiving circuits. Further, under the examiner's overly broad interpretation of the term "connector," the "electrical connector" recited in claim 1 would also read on batteries, light bulbs, motor windings, fuses, and a host of other electrical devices or elements that one of ordinary skill in the art would immediately recognize as not being covered by the term "electrical connector" in claim 1.

The applicant respectfully submits that in light of the applicants' specification, one of ordinary skill in the art would not interpret the term "multi-source agreement complaint electrical connector" to cover the Murata sending and receiving circuits (1) and (2) as contended in the official action. Thus, the Murata sending and receiving circuits (1) and (2) cannot properly be construed to be a multi-source agreement compliant electrical connector as recited in claim 1. Therefore, Murata fails to teach each and every element recited in claim 1, and claim 1 cannot be anticipated thereby. Accordingly, the applicants respectfully submit that independent claim 1 and claims 2-4 dependent thereon are in condition for allowance.

In view of the foregoing, the applicants respectfully submit that this application is in condition for allowance. If there are any remaining matters that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,



Mark G. Hanley
Registration No. 44,736
Attorney for Applicants
Hanley, Flight & Zimmerman, LLC
(at customer number **34431**)
20 North Wacker Drive
Suite 4220
Chicago, Illinois 60606
312.580.1020

Dated: **November 23, 2005**

Attorneys for Intel Corporation